

REMARKS/ARGUMENTS

In the Restriction Requirement of November 05, 2009, the Examiner has divided the claims into Groups as follows:

- Group I: Claims 1-6, drawn to a carbon fiber precursor fiber bundle.
- Group II: Claims 7-15 and 29-30, drawn to a method of making a carbon fiber precursor bundle.
- Group III: Claims 16-25, drawn to an apparatus for making a carbon fiber precursor bundle.
- Group IV: Claims 26-28, drawn to a method for using a carbon fiber precursor bundle.

Applicants elect, with traverse, Group III, Claims 16-25 (drawn to an apparatus for making a carbon fiber precursor bundle), for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted the following:

- Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
 - “Group I does not require intermingling between the tows but Group II provides [an] intermingling device.”

- Groups I and III do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
 - “Group I does not require intermingling between the tows but Group III provides [an] intermingling device.”
- Groups IV and II do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
 - “Group IV does not require intermingling between the tows but Group II provides [an] intermingling device.”
- Groups IV and III do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
 - “Group IV does not require intermingling between the tows but Group III provides [an] intermingling device.”
- Groups I and IV do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
 - “Yamanaka et al. teaches a precursor fiber bundle whose production process does not require intermingling of the fibers.”
- Groups II and III do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
 - “Arai et al. teaches an apparatus for making plural pitch fibers are divided into two or more bundles and interlacing by air flow is applied to each bundle to provide a first bundle, and plurality of the first fiber bundles are joined and interlacing by air flow is applied to the joined pitch fiber bundle to provide a second fiber bundle which corresponds to an intermingling device that comprises a yarn channel having a flat rectangular section capable of passing a plurality of small tows which are adjacent to each

other and that comprise a plurality of air jet holes. Because the special technical feature does not make a contribution over the prior art, restriction is proper.”

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship

states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims *interpreted in light of the description* was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Furthermore, 37 C.F.R. § 1.475(b) states in pertinent part:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(2) A product and a process of use of said product; . . .”

In addition, The MPEP §806.03 states:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction there between should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.”

Applicants respectfully submit that the Office has not considered the relationship of the inventions of Groups I-IV with respect to 37 C.F.R. § 1.475(b)(2) and MPEP §806.03. Therefore the burden necessary according to MPEP § 1893.03(d) to sustain the conclusion that the groups lack of unity of invention has not been met.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

OBLOON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Richard L. Treanor
Registration No. 36,379

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 07/09)